

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Kotewicz *et al.*

Appl. No. 10/024,149

Filed: December 21, 2001

For: **Cloned Genes Encoding Reverse  
Transcriptase Lacking RNase H  
Activity**

Confirmation No. 4033

Art Unit: 1652

Examiner: *To Be Assigned*

Atty. Docket: 0942.049000A/RWE/MTT

**Tenth Supplemental Information Disclosure Statement**

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants wish to bring the following information to the attention of the U.S. Patent and Trademark Office. Defendant Clontech has filed in U.S. District Court, District of Maryland, Southern Division (Civil Action Nos. AW 96-4080 and AW 00-1879) two confidential declarations by its expert Joseph O. Falkinham, III subject to a protective order ("Attorneys Eyes Only"). In view of the protective order, copies of the declarations are not being submitted herewith. The following summarizes defenses set out in the declarations.

The declarations allege that the following terms and phrases recited in the claims of parent U.S. Patent Nos. 5,244,797, 5,668,005 and 6,063,608 are indefinite and render the claims invalid: "without significant degradation," "the RNA template," "organism is a retrovirus," "said organism" and "derived from." In particular, the declarations allege that a retrovirus is not an organism. The declarations also allege that it is not clear whether "derived from" means "directly isolated" or whether further manipulation is required. In addition, one declaration alleges that the following phrases recited in the claims of U.S. Patent No. 6,063,608 are indefinite and render the claims invalid: "reduction of RNase H

activity is determined by examining the integrity of an mRNA template during cDNA synthesis” and “modifying a nucleotide sequence.”

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith. This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist.

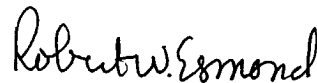
This Tenth Supplemental Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. Thus, no statement or fee is required.

Consideration of this Tenth Supplemental Information Disclosure Statement and making the same of record in the prosecution of the above-identified application is respectfully requested.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond  
Attorney for Applicants  
Registration No. 32,893

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1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600